

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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4/30/02

Applicant: Andrzej KILIAN
Title: METHODS FOR GENOTYPING BY HYBRIDIZATION ANALYSIS
Appl. No.: 09/820,328
Filing Date: March 29, 2001
Examiner: Frank Wei Min Lu
Art Unit: 1634

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

This communication is responsive to the Office communication mailed February 25, 2002, concerning the above-referenced patent application. A shortened statutory period for response expired either one month or 30 days, whichever is longer, from the date of mailing and, therefore, this response is accompanied by a Petition for a one (1) month extension of time and appropriate fee. Nevertheless, if this response lacks in the payment of any fees, the Commissioner is authorized to make appropriate charges or credits to Deposit Account No. 19-0741.

REMARKS

In the Office Action, the examiner required restriction between claims 1-40 as follows:

Group I, claims 1-22, drawn to a method of genotyping, classified in class 435, subclass 6;

Group II, claims 23-24, drawn to a method of genotyping, classified in Class 435, subclass 91.2;

Group III, claim 25, drawn to a method of genotyping, classified in Class 435, subclass 91.2;

Group IV, claims 26-30, drawn to a method of identifying a nucleic acid molecule containing a polymorphism, classified in Class 435, subclass 91.2;

Group V, claims 31-35, drawn to a method of identifying a nucleic acid molecule containing a polymorphism, classified in Class 435, subclass 91.2; and

Group VI, claims 36-40, drawn to a kit for genotyping and an ordered array of DNA molecules, classified in Class 435, subclass 287.2.

Applicants hereby provisionally elect for prosecution Group I (claims 1-22) with traverse. The Examiner also required an election of species between all the members of the *Markush* group listed in claims 19 and 20. With respect to election of species for claim 19, applicants hereby elect "plants" with traverse. With respect to election of species for claim 19, applicants hereby elect "rice" with traverse. Claims 1-22 read on the elected species.

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I. Restriction Requirement

✓ The examiner's requirement is onerous and improper for there is no undue burden imposed on the examiner to search these allegedly separate Groups. It is noted that all the Groups set forth by the examiner are searchable in only three subclasses of a single classification. In addition, Groups II, III, IV and V are all classified in the exact same subclass, class 435, subclass 91.2. In addition, not only are Groups II and III classified in the exact same class and subclass, according to the Examiner, Groups II and III are drawn to exactly the same invention, "a method of genotyping." Likewise, Groups IV and V are both drawn to the same invention, "a method of identifying a nucleic acid molecule containing a polymorphism," and classified in the same class and subclass. The examiner's carving up of the application is onerous and improper.

MPEP § 803 recites that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (emphasis added). This directive should be followed by the examiner in this case as performing a search where all the claims are in the same class and subclass does not constitute an undue burden upon the examiner.

For these reasons, applicants respectfully request that the examiner withdraw the restriction requirement and examine claims 1-40 of this application.

II. Election of Species

In the Office Action, the examiner also requires an election of species between every member of the *Markush* group of claims 19 and 20. This requirement is improper and applicants request that the examiner withdraw the requirement and examine the application in its entirety.

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MPEP § 803.02 states that "the examiner must examine all the members of the Markush group in the claim on the merits" if the members are sufficiently few in number or so closely related that a search can be made without "serious burden." The examiner cannot "refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention." Each member of the *Markush* group recited in claim 20 share a common utility in that each organism recited in claim 20 is used as source from which a diversity panel can be made according to the method of claim 1. All members of the Markush group of claim 20 share a unity of invention, because they all are used in the context of genotyping.

Moreover, claims 19 and 20 depend from claim 1 and each recite that "the organisms of step (a) are selected from the group consisting of..." (emphasis added). Claim 1, step (a) recites "generating a first diversity panel from nucleic acid molecules of two or more organisms, wherein the first diversity panel comprises a reproducible pattern of nucleic acid molecules" (emphasis added).

Thus, the claimed invention is directed to the use of two or more organisms recited in either claim 19 or claim 20. Applicants teach in the Examples of the specification at page 31, that different rice cultivars may be used to generate diversity panels in the context of the claimed invention. Furthermore, Example 8 at page 43 of the specification teaches genotyping using a mixture of rice and microorganisms.

Thus, election of a **single** species as required by the examiner, in addition to being improper as a matter of examination procedure, is nonsensical and would alter the objective of the claimed invention.

Applicants, therefore, respectfully request that the examiner withdraw the election of species requirement set forth at pages 7 and 8 of the Action.

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Nevertheless, applicants reserve the right to file one or more divisional applications covering the subject matter of the non-elected claims.

III. Conclusion

In view of the foregoing, it is respectfully urged that claims 1-40 should be examined together. An early notice of allowance is earnestly solicited. Should there be any questions, Examiner Lu is courteously invited to contact the undersigned attorney at the telephone number shown below.

Respectfully submitted,

Date: April 25, 2002

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Atty. Dkt. No. 076518-0140

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TRANSMITTAL

Commissioner for Patents
Washington, D.C. 20231

Sir:

Transmitted herewith for the above-identified application.

- ☒ Response to Restriction Requirement.
- ☐ The fee required for additional claims is calculated below:

	Claims as Amended		Previously Paid For	=	Extra Claims Present		Rate	=	Additional Claims Fee
Total Claims:	44	—	44	=	0	x	\$18.00	=	\$0.00
Independents:	10	—	10	=	0	x	\$84.00	=	\$0.00
First presentation of any Multiple Dependent Claims:						+	\$280.00	=	\$0.00
CLAIMS FEE TOTAL:									\$0.00

- ☒ Applicant hereby petitions for an extension of time under 37 C.F.R. §1.136(a) for the total number of months checked below:

<input checked="" type="checkbox"/>	Extension for response filed within the first month:	\$110.00	\$110.00
<input type="checkbox"/>	Extension for response filed within the second month:	\$400.00	\$0.00
<input type="checkbox"/>	Extension for response filed within the third month:	\$920.00	\$0.00
<input type="checkbox"/>	Extension for response filed within the fourth month:	\$1,440.00	\$0.00
<input type="checkbox"/>	Extension for response filed within the fifth month:	\$1,960.00	\$0.00
EXTENSION FEE TOTAL:			\$110.00
CLAIMS AND EXTENSION FEE TOTAL:			\$110.00
<input type="checkbox"/>	Small Entity Fees Apply (subtract ½ of above):		\$0.00
TOTAL FEE:			\$110.00

☒ A check in the amount of \$110.00 is enclosed.

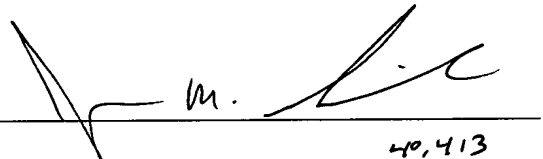
☒ The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

Date April 25, 2002

By


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